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| 10/763,072 | 01/21/2004 | Robert F. Sheppard | 200901410-1 | 3704 |

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| EXAMINER |
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KARDOS, NEIL R

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| ART UNIT | PAPER NUMBER |
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3623

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09/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| Office Action Summary | Application No. 10/763,072 | Applicant(s) SHEPPARD, ROBERT F. | |
| | Examiner Neil R. Kardos | Art Unit 3623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is a **NON-FINAL** Office Action on the merits in response to communications filed on January 21, 2004. Currently, claims 1-31 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter..

Claim 1: Claim 1 is directed toward a system. However, the claim does not positively recite any elements that necessarily constitute a system or apparatus, such as computer hardware. Rather, the claim could be directed to software. Software per se is not patentable under § 101; therefore, the claimed invention does not fall within a statutory class of patentable subject matter. *See* MPEP 2106.01.

Claim 17: Claim 17 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See in re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively

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recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Bilski*, 545 F.3d at 957; *Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform an article to a different state.

Claims 2-16 and 18-31: The dependent claims are rejected for failing to remedy the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15: It is not clear how a system can be implemented in software embodied in a computer-readable medium. A system comprises some structure such as computer hardware. It

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is not clear how computer hardware can be implemented in software embodied in a computer-readable medium. Clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ann (US 2002/0198727) in view of Northcutt (US 2003/0126001).

Claim 1: Ann discloses a system for managing information technology (IT) infrastructure of an enterprise, the system comprising a centralized logistics and management (CLAM) tool operable to:

in a capture phase:

- capture and store IT infrastructure information regarding the IT infrastructure of the enterprise (see figure 5: items 74, 342; paragraph 29; paragraph 35);
- define a plurality of roles within the enterprise, each role specifying a particular job function within the enterprise (see figure 5: item 314; paragraph 33);
- associate items of IT infrastructure with roles within the enterprise such that each role within the enterprise is associated with one or more predetermined items of IT infrastructure (see figure 5: items 314, 334, and 330; paragraphs 41 and 43-44; paragraph 46); and

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- assign roles to one or more employees of the enterprise such that each of the one or more employees is associated with one or more roles is assigned the one or more predetermined items of IT infrastructure associated with each of these one or more roles (see figure 5: items 314, 334, and 330; paragraphs 33, 46);
- in a modeling phase, automatically model a change in the IT infrastructure for one or more impacts employees of the enterprise (see paragraph 14, disclosing impact of changes in components; paragraph 47, disclosing modeling changes in IT infrastructure);

Ann does not explicitly disclose automatically initiating deployment of one or more IT infrastructure assets for the one or more impacted employees by organizing delivery of the one or more IT infrastructure assets to the one or more impacted employees to implement the change modeled in the modeling phase. However, Ann does suggest this limitation (see paragraph 47, disclosing modeling changes to the enterprise that include changes to the IT infrastructure such as application software; paragraph 43, disclosing events causing IT infrastructure to be implemented). Northcutt explicitly discloses this limitation (see paragraph 47, disclosing implementing IT assets in response to service or project requests; paragraph 63, disclosing requests for service for information technology support; paragraph 74, disclosing providing the IT service; paragraphs 7-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to deploy the changes of Ann as taught by Northcutt. This combination of known elements retains the functionality of the separate elements and produces a result that would be predictable to one of ordinary skill in the art; that is, the implementation of desired organizational changes.

Claim 2: Ann discloses wherein the IT infrastructure of the enterprise comprises one or more computer-related facilities, services, and installations used for operations of the enterprise, comprising one or more of computer hardware and computer software (see figure 5: item 74).

Claim 3: Ann discloses wherein the capture phase comprises an existing IT assets area for capturing an existing view of IT infrastructure assets of the enterprise, the existing IT assets area comprising one or more of: asset profiles for IT infrastructure assets of the enterprise (see figure 5: item 342), employee profiles for employees of the enterprise (see figure 5: item 334), location profiles for locations associated with the enterprise (see figure 5: item 320), and division profiles for divisions of the enterprise (see figure 5: item 312).

Claim 4: Ann discloses wherein the CLAM tool is further operable to, if a role assigned to a particular employee is changed to a different role, change the one or more items of IT infrastructure associated with the particular employee to reflect the different role (see paragraph 33, disclosing roles; paragraphs 46-47, disclosing modeling changes; paragraphs 13-14, disclosing change impacts).

Claim 5: Ann discloses the tool further operable to assign one or more additional items of IT infrastructure to the particular employee such that the particular employee receives the one or more additional items of IT infrastructure in addition to the one or more predetermined items of IT infrastructure associated with each of the one or more roles assigned to the particular

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employee (see paragraph 48, disclosing the flexibility of the model; see also Northcutt, paragraphs 65-67, disclosing assigned additional IT infrastructure to employees).

Claim 6: Ann discloses wherein the change in the IT infrastructure of the enterprise comprises a technology refresh for one of: a particular employee of the enterprise (see paragraph 33; figure 5: item 314), a particular group of employees of the enterprise (see paragraph 33; figure 5: item 334), all employees of a division of the enterprise (see figure 5: item 312; paragraph 42), all employees of the enterprise (see paragraph 47).

Claim 7: Ann discloses wherein the change in the IT infrastructure of the enterprise comprises a technology refresh for one or more of: a particular workspace of the enterprise, a work area comprising a plurality of workspaces, a building of the enterprise, and all sites associated of the enterprise (see figure 5: item 320; paragraphs 44 and 46).

Claim 8: Ann discloses wherein the change in the IT infrastructure comprises moving one or more employees between: particular workspaces of the enterprise, work areas of the enterprise, or buildings of the enterprise (see paragraph 46; figure 5: items 312 and 320; organization units are associated with locations and modeled to see the effects of changes).

Claim 9: Ann discloses wherein the modeling phase comprises modeling a change to the IT infrastructure of the enterprise according to one or more of: network topology considerations,

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and one or more business rules associated with the enterprise (see paragraph 32, disclosing governance rules; paragraphs 46-47).

Claim 10: Ann does not explicitly disclose wherein the deployment phase comprises user acceptance testing to determine whether one or more deployed changes in the IT infrastructure of the enterprise was successful and, if the changes were not successful, initiating a process to correct problems. Northcutt discloses this limitation (see paragraph 47, disclosing user acceptance testing; paragraph 74, disclosing user testing). It would have been obvious to one of ordinary skill in the art at the time the invention was made to test the changes proposed by Ann as taught by Northcutt. One of ordinary skill in the art would have been motivated to do so for the benefits associated with testing (e.g. ensuring that fixes work or implementations are successful).

Claim 11: Ann does not explicitly disclose the limitations of this claim. Northcutt discloses:

- receiving a change request, the change request comprising one or more of a request for a change in the IT infrastructure or a request to resolve a problem associated with the IT infrastructure (see paragraphs 46-48, disclosing project requests and service requests);
- automatically creating an incident for the change request, the incident enabling the change request to be tracked and monitored (see paragraph 78, disclosing automatically creating a request for service number);

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- determining whether to approve the change request (see paragraph 49, disclose approvals and exceptions; paragraphs 64-65, disclosing approvals);
- if the change request is approved:
 - automatically applying one or more business rules to the change request (see paragraphs 64-65, disclosing automatically change the request type; also disclosing routing the service request to the appropriate party);
 - automatically initiating deployment of IT infrastructure assets for fulfilling the change request (see paragraph 47, disclosing implementing IT assets in response to service or project requests; paragraph 63, disclosing requests for service for information technology support; paragraph 74, disclosing providing the IT service; paragraphs 7-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the change tracking system disclosed by Ann when managing the change requests of Northcutt. One of ordinary skill in the art would have been motivated to do so for the benefit of more accurate information based on the system of Ann (which provides a change impact analysis), to be used in the decision-making process.

Claim 12: Ann does not explicitly disclose the limitations of this claim. Northcutt discloses a scheduling procedure for scheduling deployment of the IT infrastructure assets for fulfilling the change request, the scheduling procedure comprising creating one or more milestones for delivery of the IT infrastructure assets for fulfilling the change request (see

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paragraph 60, disclosing a due date; paragraph 64, disclosing a critical date). Ann and Northcutt are combinable for the reasons discussed above with respect to claim 11.

Claim 13: Ann and Northcutt do not explicitly disclose that if a particular milestone is not met, notifying one or more appropriate individuals that the milestone was not met. Examiner takes Official Notice that it was well-known in the art at the time the invention was made to alert responsible parties when deadlines are not met. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine these well-known alerts with the deadlines of Northcutt. This combination of known elements retains the functionality of the separate elements and produces a result that would be predictable to one of ordinary skill in the art (e.g. sending an alert when a deadline has passed).

Claim 14: Ann does not explicitly disclose the limitations of this claim. Northcutt discloses one or more follow-up procedures for determining whether the IT infrastructure assets for fulfilling the change request were properly deployed and, if the IT infrastructure assets were not properly deployed, creating a new incident for resolving problems associated with the deployment of the IT infrastructure assets (see paragraph 47, disclosing user testing and acceptance as well as sign-off). Ann and Northcutt are combinable for the reasons discussed above with respect to claim 11.

Claim 15: Ann discloses wherein the system is implemented in software embodied in a computer-readable medium (see paragraph 25, disclosing software).

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Claim 16: Ann discloses a database operable to store the IT infrastructure information regarding the IT infrastructure of the enterprise (see paragraph 29, disclosing storing the information in a database).

Claims 17-31: Claims 17-31 are substantially similar to claims 1-15 and are rejected under similar rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kananghinis (US 2004/0059611), directed to modeling frameworks and architecture in support of a business.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

/Neil R. Kardos/
Examiner, Art Unit 3623
/Jonathan G. Sterrett/
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